

APR -4/ 2001



UNITED STATES DEPARTMENT OF COMMERCE
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Paper # 18

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In re Application of
Joseph Fisher et al
Serial No.: 09/293,670
Filed: April 16, 1999
Attorney Docket No.: A-68104

PETITION DECISION

This is in response to applicants' petition under 37 CFR 1.181, filed March 5, 2001, to withdraw the finality of the last Office action.

A review of the file history shows that the above identified application is a Continuation of SN 09/062,333 (sic - '330), and SN 09/157,748, both still pending. In a first Office action, mailed October 16, 1999, the examiner rejected claims 1-7 under 35 U.S.C. 112, first paragraph and claim 1 under the second paragraph for various reasons. Claims 8-10 were identified as improper multiple dependent claims and it was specifically stated that they would not be further treated on the merits. Claims 1-3, 5 and 6 were rejected for obvious double patenting over SN 09/062,330 and claims 1-7 were rejected for obvious double patenting over SN 09/157,748. Claims 1-4 and 7 were then rejected under 35 U.S.C. 102(a) in view of Noaln (sic - Nolan). Claim 3 was rejected under 35 U.S.C. 102(e) over Kamb. Claims 5-6 were rejected under 35 U.S.C. 103(a) over Noaln (sic - Nolan) or Kamb in view of Hide. Applicants replied on March 6, 2000, amending claims 1, 3, 5 and 7-9 and adding claims 11-14 which overcame the improper multiple dependency rejection. The other rejections were argued appropriately and submission of terminal disclaimers was indicated as being deferred until allowable subject matter was indicated. The examiner mailed a Final Office action to applicants on July 5, 2000, maintaining the rejection of claims 1-7 under 35 U.S.C. 112, first paragraph. The rejections for obvious double patenting were also maintained as no terminal disclaimers had been submitted. Claims 1-4, 7-10 and 13-14 were also rejected under 35 U.S.C. 102(a) over Nolan as before. Claims 3, 8, 10 and 14 were rejected under 35 U.S.C. 102(e) over Kamb as before. Claims 5-6 and 11-12 were rejected under 35 U.S.C. 103(a) over Nolan or Kamb in view of Hide as before. On January 5, 2001, applicants replied to the Office action offering amendments to claims 1 and 3 and adding claims 15-16 and objecting to the finality of the last Office action as rejecting claims in a manner in which they had not been rejected before. The examiner refused entry of the amendment and set forth reasons therefor. Applicants then filed this petition requesting withdrawal of the finality of the Office action alleging that it is premature.

A review of the application as filed shows that it is a continuation of two earlier filed application which contain the same or similar claims as evidenced by the rejections for obvious double patenting. Applicants are thus familiar with drafting claims in applications filed in this Office and the proper presentation of multiple dependent claims. (It is not known whether proper or

improper multiple dependent claims were presented in the earlier application.) However, the presentation of improper multiple dependent claims is considered to have been an inadvertent error in claim drafting. The examiner followed approved Office practices when acting on the claims initially by rejecting them as improper and not considering them further on the merits. (Alternatively the examiner could have considered them on the merits and applied the appropriate prior art rejections to them to the extent they could be properly understood.) Applicants' amendments in reply to the Office action correcting the improper dependencies then required the examiner to act on the claims as appropriate. The rejections of now proper claims 8-10 were no different than the rejections over prior art previously set forth and therefor are considered to have raised no new issues not previously identified to applicants in the first Office action.

In view of the above, applicant's petition is **DENIED**.

The period for filing the Appeal Brief or taking other appropriate action remains at two months from Office receipt of the Notice of Appeal, January 12, 2001.

The amendment filed March 5, 2001 will be forwarded to the examiner for appropriate consideration following the mailing of this decision.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230.



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